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VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/180,209 12/22/99 KARPUSAS

M B189

HM22/0728

BIOMER INC
14 CAMBRIDGE CENTER
CAMBRIDGE MA 02142

EXAMINER

OGIHARA, N

ART UNIT

PAPER NUMBER

1631

13

DATE MAILED:

07/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/180,209

Applicant(s)

KARPUSAS ET AL.

Examiner

Nancy Ogihara

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit **1631**.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-11, 13-18, and 25-26, drawn to a crystal of CD40 ligand and methods of preparing, and a method of using the crystal for structure.
- II. Claims 12, drawn to a machine readable storage medium storing crystallographic coordinate data.
- III. Claims 19, and 28-34, drawn to a method of identifying a compound that associates with TNF- α converting enzyme polypeptide. If this group is elected, a species election is required.
- IV. Claims 20-24 and 35-36, drawn to a chemical entity that associates with CD40 ligand or CD40, or a fragment complex or homolog thereof.
- V. Claims 27, drawn to a method of using the structural coordinates in structure determination.

SPECIES REQUIREMENT

For Group III, applicant must elect a species method for evaluating association with CD40 ligand: (A) computational, (B) experimental.

Each of the methods require differing apparatus, method steps, and criteria for evaluating association which are physically and conceptually distinct methods.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group I possesses the inventive concept of being drawn to a crystal of CD40 ligand, methods of preparing the crystal, and the method of using the crystal for structure determination. The crystal, methods of making and using are not encompassed or required by the claims of Groups II-V.

Group II possesses the inventive concept of being drawn to a computer readable medium. The inventive concept is not related to Groups I or III-V.

Group III possesses the inventive concept of being drawn to a method of designing a ligand. The method steps and parameters used are not shared or required by Groups I, II, IV, or V.

Group IV possesses the inventive concept of being drawn to a chemical entity that associates with CD40 ligand. The chemical entity is not shared by the claims of Groups I-III or V.

Group V possesses the inventive concept of being drawn to a method of using the structural coordinates of CD40 ligand for structure determination. The method steps and results of Group V are not encompassed or shared by the claims of Group I-IV.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy Ogihara whose telephone number is (703) 308-9363. The examiner can be reached Monday-Friday from 8:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Michael Woodward can be reached at (703) 308-4028.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist, whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1631 by facsimile transmission. Papers should be faxed to Group 1631 via the PTO Fax Center located in Crystal Park I. The faxing of such papers must conform with the notice published in the Official Gazette 1096 OG 30 (November 15, 1989). The CMI Fax Center number is (703) 308-4242.

Nancy Ogihara
July 25, 2000


ARDIN H. MARSCHEL
PRIMARY EXAMINER